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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057023
Party	Defendant John "Giovanni" Aragona
Correspondence Address	JOHN "GIOVANNI" ARAGONA 417 WHITEFIELD AVENUE SARASOTA, FL 34243 UNITED STATES
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Attachments	ANSWER AND AFFIRMATIVE DEFENSES OF RESPONDENT JOHN _GIOVANNI_ ARAGONA.pdf(1177999 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 4232569
Issued: October 30, 2012

In the Matter of Registration No. 4220686
Issued: October 9, 2012

In the Matter of Registration No. 4224400
Issued: October 16, 2012

In the Matter of Registration No. 4248595
Issued: November 27, 2012

LuckyU Enterprises, Inc.)	
)	
Petitioner)	
)	
v.)	Cancellation No. <u>92057023</u>
)	
John Aragona)	
)	
Registrant)	

**ANSWER AND AFFIRMATIVE DEFENSES OF
REGISTRANT JOHN “GIOVANNI” ARAGONA**

Registrant John “Giovanni” Aragona (hereinafter “Registrant” or “Aragona”) by its attorney, hereby answers and responds to the allegations set forth in the Consolidated Petition for Cancellation dated April 8, 2013 (hereinafter “the Petition”) filed by Petitioner LuckyU Enterprises, Inc. (hereinafter “Petitioner” or “Nitsche”).

For the convenience of the Board, the language of each allegation in the Petition to Cancel is repeated in single space and is followed by Registrant’s response.

Petitioner's Business and Rights in the GIOVANNI'S Marks

1. In 1997, Petitioner's predecessor in interest, Nitsche Enterprises, Inc. (hereinafter collectively referred to as "Petitioner"), purchased from Registrant John Aragona and his previous wife Connie Aragona (hereinafter collectively referred to as the "Aragonas") a retail food business, which had been selling cooked shrimp from a lunch truck in Hawaii since approximately 1993 or 1994 under the name "Giovanni's Aloha Shrimp."

ANSWER TO PARAGRAPH 1

Admitted. Registrant was selling shrimp under the name "Giovanni's Aloha Shrimp," however, the business was advertised and known as "Giovanni's White Shrimp Truck" since its inception in 1994.

2. The Asset Purchase Agreement (the "Agreement") assigned all assets of the business to Petitioner, including, inter alia, the original white shrimp truck and rights to the trade name "Giovanni's Aloha Shrimp" within the state of Hawaii. (A true and accurate copy of the Agreement is annexed hereto as Appendix A.)

ANSWER TO PARAGRAPH 2

Admitted, as to the authenticity of the Agreement attached to the Petition for Cancellation and that the agreement includes provisions that pertain to the rights to the marks currently at issue. Denied as to all other allegations in Paragraph 2.

3. The Asset Purchase Agreement also contemplated a future arm's length supplier relationship, whereby Petitioner would obtain sauces and marinades from the Aragonas to the extent they could maintain adequate supply.

ANSWER TO PARAGRAPH 3

Admitted.

4. Shortly after selling Petitioner the shrimp truck business, the Aragonas formed Giovanni's Aloha Foods to supply sauces and marinades. It quickly became apparent the Aragonas were incapable of running the business on their own, and so members of Petitioner, Troy Nitsche and James Goodrich, invested in, became 50% owners in, and eventually had to run, and then shut down the failed company after the Aragonas abandoned operations.

ANSWER TO PARAGRAPH 4

Registrant admits to forming Giovanni's Aloha Foods to supply sauces and marinades shortly after selling Petitioner a portion of the shrimp truck business. Registrant admits Troy Nitsche and James Goodrich, invested in, and became 50% owners in Giovanni's Aloha Foods. Otherwise, Registrant denies the allegations contained in Paragraph 4 of the Petition for Cancellation.

5. In August 2001, Mrs. Aragona, with the help of three hired assailants, attacked Mr. Nitsche, pistol-whipped him, pointed a gun at his head, and threatened him and his family if he did not sign over the papers to the shrimp truck business; that same day, they stole Petitioner's cash box containing \$3,500.

ANSWER TO PARAGRAPH 5

Registrant divorced Mrs. Connie Aragona in May of 2000, thus the allegations of her actions in Paragraph 5 have no reasonable relationship to this matter. Registrant requests Paragraph 5 be stricken.

6. Mrs. Aragona was convicted of robbery, kidnapping, and theft, and remains in prison for her crimes against Mr. Nitsche and Petitioner.

ANSWER TO PARAGRAPH 6

Registrant divorced Mrs. Connie Aragona in May of 2000, thus the allegations of her actions in paragraph 6 have no reasonable relationship to this matter. Registrant requests Paragraph 6 be stricken.

7. After abandoning the failed Giovanni's Aloha Foods, Mr. Aragona disappeared from the scene for a decade.

ANSWER TO PARAGRAPH 7

Denied.

8. During this time, and despite all of the problems caused by the Aragonas, Petitioner's shrimp truck business took off and became exponentially more successful than ever before.

ANSWER TO PARAGRAPH 8

Assuming the timeframe Petitioner is referring to is the ten years following execution of the Agreement, Registrant admits that Petitioner's shrimp truck business took off and became exponentially more successful than ever before. Registrant denies causing problems.

9. Opposer and/or its predecessors adopted and used, and Opposer continues to use and have prior rights in, inter alia, the following marks (collectively referred to as Petitioner's "GIOVANNI'S Marks"):

GIOVANNI'S ALOHA SHRIMP
GIOVANNI'S SHRIMP TRUCK
GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK

ANSWER TO PARAGRAPH 9

Admitted as to Petitioner's continued use of GIOVANNI'S ALOHA SHRIMP, GIOVANNI'S SHRIMP TRUCK, and GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK. Denied as to all other allegations.

[Petitioner uses the term "Opposer" for the first and only time in paragraph 9. Under the assumption that this was inadvertent, Registrant's answer is made taking the term "Opposer" to refer to Petitioner.]

10. Since buying the business in 1997, Petitioner has owned and continuously used the mark GIOVANNI'S ALOHA SHRIMP in connection with the sale of shrimp and related food from its shrimp trucks. The Asset Purchase Agreement states Petitioner agrees not to register the trade name "Giovanni's Aloha Shrimp" outside of the state of Hawaii, and Petitioner has never done so.

ANSWER TO PARAGRAPH 10

Registrant admits that Petitioner has continuously used the mark GIOVANNI'S ALOHA SHRIMP in connection with the sale of shrimp and related food from its shrimp truck since 1997. Registrant admits that the Asset Purchase Agreement states Petitioner

agrees not to register the trade name “Giovanni’s Aloha Shrimp” outside of the state of Hawaii. Otherwise, Registrant denies all other allegations contained in Paragraph 10 of the Petition for Cancellation.

11. Since buying the business in 1997, Petitioner has owned and continuously used the mark GIOVANNI’S SHRIMP TRUCK in connection with the sale of shrimp and related food from its shrimp trucks.

ANSWER TO PARAGRAPH 11

Registrant admits that Petitioner has continuously used the mark GIOVANNI’S SHRIMP TRUCK in connection with the sale of shrimp and related food from its shrimp trucks since buying the business in 1997. Registrant denies the allegation that Petitioner has owned the mark GIOVANNI’S SHRIMP TRUCK since 1997.

12. Since at least as early as March 1, 1998, Petitioner adopted and has owned and continuously used the mark GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK in connection with the sale of shrimp and related food from its shrimp trucks.

ANSWER TO PARAGRAPH 12

Registrant admits that Petitioner has continuously used the mark GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK in connection with the sale of shrimp and related food from its shrimp trucks since buying the business in 1997. Registrant denies the allegation that Petitioner has owned the mark GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK since 1997.

13. Petitioner advertises its shrimp truck business in connection with Petitioner’s GIOVANNI’S Marks through, inter alia, its website located at www.giovanisshrimptruck.com, signage on the property (such as the signage depicted below), and the Giovanni’s Original White Shrimp Truck, which resides on the property (as depicted below)

ANSWER TO PARAGRAPH 13

Admitted.

14. Since Petitioner took over in 1997, its shrimp truck business grew from annual sales of approximately \$25,000 to a multi-million dollar business with multiple locations and over thirty employees dedicated to providing the highest quality food and food services in connection with Petitioner's GIOVANNI'S Marks.

ANSWER TO PARAGRAPH 14

Admitted.

15. Due to Petitioner's advertising and sales, word of mouth advertising by customers, and unsolicited third party recognition by the media and food magazines and critics, such as Saveur Magazine, consumers have come to recognize Petitioner's GIOVANNI'S Marks as a singular indication of origin, as a consequence of which Petitioner has established valuable goodwill and exclusive rights in its marks.

ANSWER TO PARAGRAPH 15

Admitted as to consumer's recognition of the GIOVANNI'S Marks. Denied as to the remainder of Paragraph 15. The valuable goodwill and exclusive rights accrue to Registrant.

16. In addition to common law rights in Petitioner's GIOVANNI'S Marks, Petitioner also owns federal applications for the marks GIOVANNI'S SHRIMP TRUCK (Serial No. 85897872) and GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK (Serial No. 85897861), both for food truck and related restaurant services.

ANSWER TO PARAGRAPH 16

Denied as to Petitioner having any common law rights to the GIOVANNI'S Marks apart from his contractual right to use them. Admitted as to Petitioner owning federal applications for the marks GIOVANNI'S SHRIMP TRUCK (Serial No. 85897872) and GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK (Serial No. 85897861).

Registrant's Fraudulent Activities and Registrations

17. Appreciating that Petitioner's business has achieved immense success, Mr. Aragona has now resurfaced, after a decade, in an attempt to improperly capitalize on Petitioner's hard-earned goodwill through fraudulent and deceptive conduct that suggests a false connection with Petitioner and through misuse of fraudulently obtained registrations.

ANSWER TO PARAGRAPH 17

Denied.

18. Each of the marks for which Registrant obtained a fraudulent registration appears on Registrant's website, located at www.giovannissauces.com, in close proximity to a picture of one of Petitioner's distinctive shrimp trucks. In fact, each and every page of Registrant's website prominently features a picture of Petitioner's shrimp truck and the following advertising language intended to suggest a false association or affiliation with, or endorsement by, Petitioner: "What began as an unknown shrimp truck on Oahu's North Shore – Became a Legend!" (A true and accurate copy of screenshot printout of Registrant's Home Page, located at www.giovannissauces.com, is annexed hereto as Appendix B.)

ANSWER TO PARAGRAPH 18

Admitted as to the items appearing on Registrant's website, located at www.giovannissauces.com. Denied as to fraudulently registering the marks. Denied as to an intention to suggest a false association or affiliation with, or endorsement by, Petitioner.

19. Registrant's website also prominently features putative customer comments about Registrant, which really refer to Petitioner's shrimp truck business, such as the following statements:

"Our friend told us to stop at the 'White Shrimp Truck' in Kahuku, and we're glad we did!"

"We really enjoyed dining daily at the white shrimp truck, during our recent vacation."

(A true and accurate copy of a printout of Registrant's About Us page, located at www.giovannissauces.com/about, is annexed hereto as Appendix C.)

ANSWER TO PARAGRAPH 19

Admitted.

20. Registrant's website and advertising materials were intentionally designed to create the false impression that Registrant is somehow affiliated with Petitioner and

attempt to trade off the goodwill associated with Petitioner's GIOVANNI'S Marks and shrimp truck business.

ANSWER TO PARAGRAPH 20

Denied.

21. Registrant's fraudulently procured registrations further manifest his intent to deceive the USPTO and consumers as to a false relationship with Petitioner.

ANSWER TO PARAGRAPH 21

Denied.

22. On September 21, 2011, Registrant filed an application for registration of the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK for mobile restaurant services (U.S. Registration No. 4232569), claiming a date of first use in commerce of February 1, 1994.

ANSWER TO PARAGRAPH 22

Admitted.

23. The specimen of use Registrant submitted with its application for GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK depicts a picture of Petitioner's sign located on Petitioner's business premises. The specimen of use also depicts Petitioner's original shrimp truck, which is well.known and famously referred to as "Giovanni's Original White Shrimp Truck." This truck was specifically itemized as an asset assigned and transferred to Petitioner in Exhibit A to the Asset Purchase Agreement. (A true and accurate copy of this specimen printed from the United States Patent and Trademark Office's (USPTO) Trademark Document Retrieval (TDR) system is annexed hereto as Appendix D, and depicted below.)

ANSWER TO PARAGRAPH 23

Admitted.

24. In the application for GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK, Registrant falsely describes the specimen of use as follows: "Photo of Giovanni's Original White Shrimp Truck and Sign."

ANSWER TO PARAGRAPH 24

Denied as to the description being false, it is as Petitioner states in Paragraph 22 above, a photo of Giovanni's Original White Shrimp Truck and Sign. Admitted as to the remainder.

25. Petitioner never authorized or otherwise gave permission to Registrant to depict Petitioner's sign bearing Petitioner's mark and advertising Petitioner's business, or use a photo Petitioner's shrimp truck, in connection with Registrant's business. Petitioner also never authorized or otherwise gave permission to Registrant to use or register the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK, which is identical to the mark in which Petitioner has prior rights.

ANSWER TO PARAGRAPH 25

Denied.

26. Registrant has never used the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK in connection with mobile restaurant services.

ANSWER TO PARAGRAPH 26

Denied.

27. Registrant has not continuously or exclusively used the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK in connection with mobile restaurant services since February 1, 1994.

ANSWER TO PARAGRAPH 27

Denied.

28. In the alternative, to the extent Registrant ever used the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK in connection with mobile restaurant services, Registrant abandoned any such rights.

ANSWER TO PARAGRAPH 28

Denied.

29. In procuring the application which matured into Registration No. 4232569 of the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK, Registrant knowingly provided false and misleading statements and information concerning its use and ownership of the mark, including a false and misleading declaration signed by Jamie Pitts, with the intent to deceive the USPTO and the public as to the source of goods sold

under the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK and to knowingly misappropriate Petitioner's valuable goodwill and exclusive rights in the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK.

ANSWER TO PARAGRAPH 29

Denied.

30. Registrant's use of the identical mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK for identical mobile restaurant services is likely to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Federal Trademark Act.

ANSWER TO PARAGRAPH 30

Denied.

31. Registrant's use of the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK in the manner described above also is deceptive and falsely suggests a connection with Petitioner within the meaning of Section 2(a) of the Federal Trademark Act.

ANSWER TO PARAGRAPH 31

Denied.

32. On September 21, 2011, Registrant filed an application for registration of the mark GIOVANNI'S ALOHA FOODS for food preparation services (U.S. Registration No. 4220686), claiming a date of first use in commerce of June 1, 1997.

ANSWER TO PARAGRAPH 32

Admitted.

33. The specimen of use Registrant submitted with its application for GIOVANNI'S ALOHA FOODS depicts no less than five pictures of Petitioner's shrimp truck. (A true and accurate copy of this specimen printed from the United States Patent and Trademark Office's (USPTO) Trademark Document Retrieval (TDR) system is annexed hereto as Appendix E.) In fact, a couple of the images in the specimen of use actually show Petitioner's food for sale from Petitioner's shrimp truck, as can be seen below:

ANSWER TO PARAGRAPH 33

Admitted.

34. In the application for GIOVANNI'S ALOHA FOODS, Registrant falsely describes the specimen of use, in part, as follows: "Pictures of the Giovanni's Aloha Foods Original White Shrimp Truck."

ANSWER TO PARAGRAPH 34

Denied as to the description being false. Admitted as to the remainder.

35. Petitioner never authorized or otherwise gave permission to Registrant to depict Petitioner's shrimp truck or food sold by Petitioner, or to use a photo of Petitioner's shrimp trucks, in connection with Registrant's business. Neither did Petitioner authorize or otherwise give permission to Registrant to create a false impression of an association or affiliation with, or endorsement by, Petitioner.

ANSWER TO PARAGRAPH 35

Denied.

36. Registrant has not continuously or exclusively used the mark GIOVANNI'S ALOHA FOODS in connection with food preparation services since June 1, 1997.

ANSWER TO PARAGRAPH 36

Denied.

37. At most, Registrant was permitted to use the mark GIOVANNI'S ALOHA FOODS until sometime in 2001 when he abandoned the company Giovanni's Aloha Foods—a company in which Registrant owned a 25% share and Petitioner's members collectively owned a 50% share—and his right to use the mark GIOVANNI'S ALOHA FOODS.

ANSWER TO PARAGRAPH 37

Denied.

38. Neither Petitioner nor its members ever gave Registrant permission to recommence use of the mark GIOVANNI'S ALOHA FOODS, or to use the mark in the manner described herein.

ANSWER TO PARAGRAPH 38

Denied.

39. In procuring the application which matured into Registration No. 4220686 of the mark GIOVANNI'S ALOHA FOODS, Registrant knowingly provided false and misleading statements and information concerning its use and ownership of the mark, including a false and misleading declaration signed by Jamie Pitts, with the intent to deceive the USPTO and the public as to the source of goods sold under the mark GIOVANNI'S ALOHA FOODS and to knowingly misappropriate Petitioner's valuable goodwill and exclusive rights in Petitioner's GIOVANNI'S Marks.

ANSWER TO PARAGRAPH 39

Denied.

40. Registrant's use of the mark GIOVANNI'S ALOHA FOODS for food preparation services, in the manner described herein, is likely to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Federal Trademark Act.

ANSWER TO PARAGRAPH 40

Denied.

41. Registrant's use of the mark GIOVANNI'S ALOHA FOOD in the manner described herein also is deceptive and falsely suggests a connection with Petitioner within the meaning of Section 2(a) of the Federal Trademark Act.

ANSWER TO PARAGRAPH 41

Denied.

42. On September 21, 2011, Registrant filed an application for registration of the mark GIOVANNI'S SCAMPI MARINADE for marinades (U.S. Registration No. 4224400), claiming a date of first use in commerce of February 2, 1994.

ANSWER TO PARAGRAPH 42

Admitted.

43. Registrant has not continuously or exclusively used the mark GIOVANNI'S SCAMPI MARINADE in connection with marinades since February 2, 1994.

ANSWER TO PARAGRAPH 43

Denied.

44. At most, Registrant used the mark GIOVANNI'S SCAMPI MARINADE until sometime in 2001 when he abandoned the company Giovanni's Aloha Foods—a

company in which Registrant owned a 25% share and Petitioner's members collectively owned a 50% share—and his right to use the mark GIOVANNI'S SCAMPI MARINADE.

ANSWER TO PARAGRAPH 44

Denied.

45. Neither Petitioner nor its members ever gave Registrant permission to recommence use of the mark GIOVANNI'S SCAMPI MARINADE, or to use the mark in the manner described herein.

ANSWER TO PARAGRAPH 45

Denied.

46. In procuring the application which matured into Registration No. 4224400 of the mark GIOVANNI'S SCAMPI MARINADE, Registrant knowingly provided false and misleading statements and information concerning its use and ownership of the mark, including a false and misleading declaration signed by Jamie Pitts, with the intent to deceive the USPTO and the public as to the source of goods sold under the mark GIOVANNI'S SCAMPI MARINADE and to knowingly misappropriate Petitioner's valuable goodwill and exclusive rights in Petitioner's GIOVANNI'S Marks.

ANSWER TO PARAGRAPH 46

Denied.

47. Registrant's use of the mark GIOVANNI'S SCAMPI MARINADE for marinades, in the manner described herein, is likely to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Federal Trademark Act.

ANSWER TO PARAGRAPH 47

Denied.

48. Registrant's use of the mark GIOVANNI'S SCAMPI MARINADE in the manner described herein also is deceptive and falsely suggests a connection with Petitioner within the meaning of Section 2(a) of the Federal Trademark Act.

ANSWER TO PARAGRAPH 48

Denied.

49. On September 21, 2011, Registrant filed an application for registration of the mark GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE for hot sauce (U.S. Registration No. 4248595), claiming a date of first use of February 2, 1994.

ANSWER TO PARAGRAPH 49

Admitted.

50. Registrant has not continuously or exclusively used the mark GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE in connection with hot sauce since February 2, 1994.

ANSWER TO PARAGRAPH 50

Denied.

51. At most, Registrant used the mark GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE until sometime in 2001 when he abandoned the company Giovanni's Aloha Foods—a company in which Registrant owned a 25% share and Petitioner's members collectively owned a 50% share—and his right to use the mark GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE.

ANSWER TO PARAGRAPH 51

Denied.

52. Neither Petitioner nor its members ever gave Registrant permission to recommence use of the mark GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE, or to use the mark in the manner described herein.

ANSWER TO PARAGRAPH 52

Denied.

53. In procuring the application which matured into Registration No. 4248595 of the mark GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE, Registrant knowingly provided false and misleading statements and information concerning its use and ownership of the mark, including a false and misleading declaration signed by Jamie Pitts, with the intent to deceive the USPTO and the public as to the source of goods sold under the mark GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE and to knowingly misappropriate Petitioner's valuable goodwill and exclusive rights in Petitioner's GIOVANNI'S Marks.

ANSWER TO PARAGRAPH 53

Denied.

54. Registrant's use of the mark GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE for hot sauce, in the manner described herein, is likely to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Federal Trademark Act.

ANSWER TO PARAGRAPH 54

Denied.

55. Registrant's use of the mark GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE in the manner described herein also is deceptive and falsely suggests a connection with Petitioner within the meaning of Section 2(a) of the Federal Trademark Act.

ANSWER TO PARAGRAPH 55

Denied.

56. Beginning in May 2011, Registrant sent a letter to Petitioner making false ownership claims in the above marks for which Registrant obtained fraudulent registrations in an attempt to cause Petitioner to license use of the marks from Registrant.

ANSWER TO PARAGRAPH 56

Admitted as to Registrant sending a letter and the date of one of the letters sent to Petitioner. Registrant denies the remainder of Paragraph 56.

57. In February 2013, Registrant repeated this attempt to extort a license from Petitioner, relying on misstatements of fact and law and otherwise misusing its fraudulently procured trademarks to thwart competition and lawful and fair uses of Petitioner's GIOVANNI'S Marks.

ANSWER TO PARAGRAPH 57

Admitted as to Registrant sending a letter and the date of one of the letters sent to Petitioner. Registrant denies the remainder of Paragraph 57.

58. For all of the reasons set forth above, Petitioner is being damaged by the continued existence of Registration Nos. 4232569, 4220686, 4224400, and 4248595, and the business and goodwill of Petitioner is further damaged in that said registrations tend

to create or maintain statutory rights in violation and derogation of the established rights of Petitioner.

ANSWER TO PARAGRAPH 58

Denied.

AFFIRMATIVE DEFENSES

In addition to the answers provided above Registrant hereby asserts the following affirmative defenses:

FACTS COMMON TO ALL ALLEGATIONS

1. Having made continuous use of and established goodwill in the same since 1994, Registrant is the senior user of the common law trademarks GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK; GIOVANNI'S ALOHA FOOD; GIOVANNI'S SCAMPI MARINADE; and GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE (hereinafter collectively referred to as "the GIOVANNI'S Marks").
2. The GIOVANNI'S Marks are a group of marks that have a recognizable common characteristic, wherein the marks are composed and have been used in such a way that the public associates not only the individual marks, but also the common characteristic "GIOVANNI" of the GIOVANNI'S Marks family, with "Giovanni" Aragona.

LICENSEE ESTOPPEL

3. Petitioner has claimed, and Petitioner has admitted, the authenticity of the Agreement attached to the Petition and that the agreement includes provisions that pertain to the rights Registrant granted to Petitioner to use a mark derived from the GIOVANNI'S Marks. Neither party disputes that it is subject to the agreement.

4. By entering into the Agreement, Petitioner, as licensee, recognized Registrant's, the licensor's, ownership of the Giovanni's marks and by implication, covenanted not to challenge the licensor's rights.

5. The express terms of the agreement contradict Petitioner's allegations of assignment of all assets, including assignment of the rights to the GIOVANNI'S Marks. The Agreement's preamble clearly communicates the parties' intentions in entering into the agreement, it stipulates that "the Buyer desires to purchase and the Seller desires to sell *a portion* of the assets of the business operated by Seller known as "Giovanni's Aloha Shrimp," and Buyer desires to purchase the exclusive rights in the State of Hawaii, to (a) *use* the name "Giovanni's Aloha Shrimp," (b) *use* for the purpose of selling shrimp either at retail or wholesale the Giovanni's Scampi and Giovanni's Hot and Spicy shrimp sauces..." [emphasis added]

6. Registrant's permission to use the marks was granted with attendant provisions to protect the quality of the goods and services bearing the licensed marks. The express "quality control" provisions are found in Paragraph 10 of the 1997 Agreement, titled "Terms that Survive Closing."

7. Specifically, the Agreement states that Petitioner was (1) proscribed from using the marks outside of Hawaii, (2) proscribed from registering the marks outside of Hawaii; (3) obligated to sell at least a half pound of shrimp in the plate lunches sold by Buyer; (4) obligated to use the same scampi sauce and hot and spicy sauce that the Registrant used as marination and sauces for the shrimp sold by Petitioner after acquiring the Registrant's business, (5) provision of training, and (6) obligated to purchase the scampi sauce and hot and spicy sauce from Registrant or Registrant's bottler.

8. Additionally, Section 17 of the Agreement gives Registrant a means to enforce these quality control obligations by reserving the right to cancel the Agreement, as such cancellation would effectively terminate the trademark license it contains as well.

9. Registrant also competently monitors the quality of Petitioner's operation and compliance with the Agreement's quality control provisions through (1) trips Registrant has made to Hawaii over the term of the license wherein he personally sampled the food sold by Petitioner to confirm compliance; (2) contact with locals who frequent the restaurant who have never reported issues with quality, (3) continued knowledge of the restaurant's operations has been provided to Registrant by news papers, books, magazines, and websites that have publically and consistently posted reviews reporting details regarding the portion size, the sauces used, the overall quality of the food and services Petitioner provides, that Petitioner uses the same menus, serves the same food as Registrant had, and has continued to use the same sauce as required; and (4) Registrant's relationship to Petitioner who Petitioner admits to previously co-owning a related business with Registrant.

10. Further, Registrant claims by judicial admission and Petitioner admitted, not only that there was no depreciation of the quality of the restaurant services rendered during the period of the license, but that the quality and value of the goodwill continued to increase during this period as well. Thus, Registrant has justifiably relied on the integrity of the Petitioner to ensure the consistent quality of the services performed under the mark under the circumstances.

11. All of the above evidences the intent of the parties and shows that Registrant retained ownership and control of the marks at issue when he sold his business to Petitioner in 1997.

12. Petitioner is estopped from challenging the validity of the Mark based on facts that occurred during the term of the license under the doctrine of licensee estoppel. As the Petition fails to allege any facts that occurred outside of the term of the Agreement, the Petition fails to state a claim upon which relief can be granted.

13. Petitioner admitted that Registrant's use of "GIOVANNI'S ALOHA FOODS" dates minimally as far back as 1994 and that its right to use the GIOVANNI'S marks stemmed from the Registrant's agreement in 1997. Petitioner has also admitted it has continuously used the marks in question since execution of the Agreement in 1997. As such, Petitioner's use of the GIOVANNI'S marks is use by a licensee that inures to the benefit of Registrant.

14. As a licensee, Petitioner is estopped from: (1) claiming any rights against the licensor which are inconsistent with the terms of the license, (2) contesting the validity of the mark, (3) challenging the license agreement as void or against public policy, (4) claiming that the licensor abandoned its rights by failing to exercise adequate quality control during the term of the license. This is true even after the license expires.

CONTRACTUAL AND EQUITABLE ESTOPPEL

15. The arguments for the equitable defense of Licensee Estoppel are incorporated herein by reference.

16. Petition to cancel Registrant's registrations for marks is barred by the Doctrine of Contractual Estoppel, since Petitioner paid a lump-sum to license marks, and was a licensee of Registrant's marks, for more than 16 years, during which time he acknowledged validity of marks and benefited from goodwill associated with them.

17. Petitioner agreed to express contractual provisions that bar its assertion of rights to the GIOVANNI'S marks outside of the State of Hawaii (Paragraph 10A) and that specifically reserved the right of Registrant to continue to do so (Paragraph 10B). Petitioner further agreed to express provisions that allow Registrant's continued use of the same marks in connection with selling sauces and providing restaurant services, and that Registrant could do so within the same geographic area under certain limitations (Paragraph 15). Petitioner agreed to these provisions knowing that it would simultaneously be using the same marks in connection with the same goods and services.

18. All of the above lead Registrant to reasonably infer that Petitioner would not assert superior rights or claims of likelihood of confusion against Registrant. Registrant relied on Petitioner's express assurances and the terms of the Agreement from the time he entered into the agreement in 1997 to present date. Registrant would not have entered into the Agreement if its terms effectively transferred and assigned all rights Registrant had in the marks under any circumstances, and definitely not for the amount of consideration that was paid under the Agreement's terms.

19. Due to this reliance, Registrant has been and will be materially prejudiced, if Petitioner is permitted to make such improper assertion of rights.

OWNERSHIP AND PRIORITY

20. The arguments for the equitable defense of Licensee Estoppel are incorporated herein by reference.

21. When entering into the Agreement in 1997, Petitioner acknowledged and required Registrant to warranty the fact that “Seller (Registrant) is the only individual or entity that owns any rights to the Giovanni’s Scampi, and Giovanni’s Hot and Spicy shrimp sauces and Seller has the full right to contract with the Buyer as to any agreement regarding the sale and use of said sauces” (Para. 5E). Further, Paragraph 5G states, “all representations and warranties of the Seller contained in this Paragraph 5 shall survive closing.”

22. In 1997 Petitioner also agreed to express terms that acknowledged Registrant as the owner of the marks, and that Petitioner was purchasing “the exclusive rights in the State of Hawaii, to (a) *use* the name “Giovanni’s Aloha Shrimp,” (b) *use* for the purpose of selling shrimp either at retail or wholesale the Giovanni’s Scampi and Giovanni’s Hot and Spicy shrimp sauces...” (Recitals, Para 2.).

23. In its Petition for Cancellation, Petitioner admits that Registrant’s use of the mark “Giovanni’s Aloha Shrimp” dates minimally as far back as 1994.

24. Petitioner admits continuous use of the GIOVANNI’S ALOHA SHRIMP mark since 1997 (Petition, Para. 10). Petitioner admits continuous use of the GIOVANNI’S ALOHA SHRIMP mark since 3-01-1998 in the Trademark Application assigned Serial Number 85201288 filed and signed by Troy Nitsche December 18, 2010.

25. Petitioner admits continuous use of the GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK mark since 1998 (Petition, Para. 12). Petitioner admits continuous use of the GIOVANNI’S ORIGINAL WHITE SHRIMP mark since 3-01-1998 in the Trademark

Application assigned Serial Number 85201283 filed and signed by Troy Nitsche in December 18, 2010.

25. Petitioner admits continuous use of the GIOVANNI'S ORIGINAL SCAMPI SAUCE mark since 3-30-2001 in the Trademark Application assigned Serial Number 85219363 filed and signed by Troy Nitsche January 17, 2011.

26. Petitioner admits continuous use of the GIOVANNI'S ORIGINAL HOT SAUCE mark since 3-30-2001 in the Trademark Application assigned Serial Number 85219370 filed and signed by Troy Nitsche January 17, 2011.

27. The marks at issue in this Cancellation and the marks that Registrant granted Petitioner a license to use in 1997 do not create distinctly different commercial impressions, and thus are legally equivalent marks. As such, Petitioner's use of the GIOVANNI'S marks is use by a licensee that inures to the benefit of Registrant.

FAILURE TO STATE A CLAIM

28. The arguments for all affirmative defenses are incorporated herein by reference.

29. Petitioner has failed to state a claim for which relief can be granted for the following reasons, *inter alia*:

30. The Petition fails to allege Petitioner's priority of use, or that Petitioner has made any use of GIOVANNI'S ALOHA FOODS, GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE, or GIOVANNI'S SCAMPI MARINADE, thus Petitioner failed to state a claim for False Suggestion of a Connection, Priority, and Likelihood of Confusion.

31. Further, Petitioner has failed to state a claim for False Suggestion of Connection because the ground is personal to the person or institution named in the mark, and may only be asserted by that person, who in this case is Registrant.

32. Each trademark application submitted by Registrant contains a statement of use and specimen that truthfully apprised the Office of how the mark was being used. Further, related-company use does not require stating an exception, because the statement that no one else has the right to use the mark refers only to adverse users and not to licensed or permitted use. Thus, Petitioner fails to state a claim for Fraud.

33. The express terms in the Agreement that pertain to quality control combined with Petitioner's judicial admissions preclude Petitioner from meeting its burden under the stringent standard of proof to show abandonment of the trademark, thus Petitioner has failed to state a viable claim a for Abandonment.

34. Registrant will assert any other affirmative defenses or compulsory or permissive counterclaims that may be developed throughout discovery and testimony periods in this proceeding.

WHEREFORE, Registrant respectfully asks the Board to consider the agreement, its construction, and/or its validity if necessary to decide the issues properly before the Board; and

WHEREFORE, Registrant respectfully requests that judgment be entered in favor of Registrant and the Petition for Cancellation be dismissed in its entirety with prejudice.

Respectfully submitted this the 17th day of May 2013.

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CERTIFICATE OF SERVICE

This is to certify that on this 17th day of May 2013, a copy of the foregoing Answer and Affirmative Defenses were mailed by First Class mail, postage prepaid, to the following attorney of record:

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